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13 UNITED STATES DISTRICT COURT  
14 NORTHERN DISTRICT OF CALIFORNIA

15  
16 FINJAN LLC,  
17 Plaintiff,  
18 v.  
19 PALO ALTO NETWORKS, INC.,  
20 Defendant.

Case No. 3:14-CV-04908-JD

**PALO ALTO NETWORKS,  
INC.'S MOTION FOR LEAVE TO  
AMEND ITS INVALIDITY  
CONTENTIONS**

Date: February 3, 2022  
Time: 10:00 a.m.  
Courtroom: 11, 19th Floor  
Judge: Honorable James Donato

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## **NOTICE OF MOTION AND MOTION**

TO ALL PARTIES AND COUNSEL OF RECORD:

3 PLEASE TAKE NOTICE that on February 3, 2022, at 10:00 a.m., or as soon thereafter as  
4 the matter may be heard in the United States District Court for the Northern District of California,  
5 San Francisco Division, in Courtroom 11 before the Honorable James Donato, Defendant Palo  
6 Alto Networks, Inc. (“PAN”) will and hereby does submit its motion to move the Court for an  
7 Order granting leave for PAN to amend its May 17, 2021 Invalidity Contentions for U.S. Patent  
8 No. 7,647,633 (the “633 Patent”), U.S. Patent No. 8,225,408 (the “408 Patent”), U.S. Patent  
9 No. 7,418,731 (the “731 Patent”), and U.S. Patent No. 8,141,154 (the “154 Patent”)  
10 (collectively, the “Asserted Patents”) to include supplemental contentions served on Finjan, LLC  
11 (“Finjan”) on July 6, 2021 and October 6, 2021.

## **RELIEF REQUESTED**

13 Pursuant to Patent Local Rules 3-3 and 3-6, PAN seeks an Order from the Court granting  
14 leave for PAN to amend its invalidity contentions for the Asserted Patents to include  
15 supplemental invalidity contentions served on Finjan on July 6, 2021 and October 6, 2021.

## **STATEMENT OF ISSUES**

17        1. Whether there is good cause for PAN to amend its invalidity contentions to include  
18 (1) The SurfinGate System (“SurfinGate”), (2) The Check Point FireWall-1 System (“Check  
19 Point FireWall-1”), and (3) The IBM/Symantec Digital Immune System (“Digital Immune”), as  
20 set forth in its supplemental contentions served on Finjan.

21        2. Whether there is good cause for PAN to amend its invalidity contentions to  
22 address other prior art and invalidity arguments, as set forth in PAN's supplemental contentions  
23 served on Finjan.

1                   **MEMORANDUM OF POINTS AND AUTHORITIES**

2                   **I. INTRODUCTION**

3                   PAN seeks leave to amend its invalidity contentions to rely on prior art known to Finjan  
4                   and that was at issue in Finjan's previous litigations involving the Asserted Patents ("the Related  
5                   Finjan Cases").<sup>1</sup> PAN's proposed amended contentions include (1) amended contentions that  
6                   expand an already-disclosed prior art reference (Check Point FireWall-1) to a second asserted  
7                   patent, add two prior art references also previously known to Finjan (SurfinGate and Digital  
8                   Immune), and include certain additional details clarifying PAN's initial contentions ("July 6  
9                   Contentions"); and (2) amended contentions comprising claim charts corresponding to PAN's  
10                  July 6 Contentions ("October 6 Contentions"). These amendments are based on information PAN  
11                  acquired after the deadline for service of its initial invalidity contentions. Finjan opposes PAN's  
12                  motion in its entirety, despite that PAN's amendments include, in part, additional details that  
13                  Finjan requested PAN include. Finjan did not inform PAN why it opposes the very amendments  
14                  it requested.

15                  Good cause exists for PAN's amended contentions. Before serving its initial invalidity  
16                  contentions, PAN served discovery on Finjan seeking prior art and other information related to  
17                  invalidity that had been disclosed or exchanged in the Related Finjan Cases. But Finjan  
18                  improperly withheld this prior art and other invalidity-related information until after PAN served  
19                  its initial contentions. Finjan then pushed PAN for clarifying details regarding PAN's initial  
20                  contentions—which PAN agreed to provide—but continued to withhold the prior art and other  
21                  invalidity-related information. Finjan ultimately produced some information—including claim  
22                  charts from the Related Finjan Cases for SurfinGate and Digital Immune—and the parties agreed  
23                  that PAN would serve supplemental invalidity contentions by July 6, 2021. PAN abided by the  
24                  parties' agreement. On July 6, 2021, PAN served supplemental contentions that added

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25  
26                  <sup>1</sup> The Related Finjan Cases include *Finjan v. SonicWall* (N.D. Cal. No. 5:17-cv-04467),  
27                  *Finjan v. Rapid7* (D. Del. No. 1:18-cv-01519), *Finjan v. Qualys* (N.D. Cal. No. 4:18-cv-07229),  
28                  *Finjan v. Cisco* (N.D. Cal. No. 5:17-cv-00072), *Finjan v. Juniper* (N.D. Cal. No. 3:17-cv-05659),  
29                  *Finjan v. ESET* (S.D. Cal. No. 3:17-cv-00183), and *Finjan v. Check Point* (N.D. Cal. No. 3:18-  
30                  cv-02621).

1 contentions based on the belatedly-disclosed SurfinGate and Digital Immune, expanded its  
2 reliance on Check Point FireWall-1 to another asserted patent, and added certain additional detail  
3 to its contentions. PAN continued to diligently seek discovery related to SurfinGate, Check Point  
4 FireWall-1, and Digital Immune. On October 6, 2021, PAN served limitation-by-limitation claim  
5 charts for these prior art references and updated its original contentions.

6 Critically, Finjan would not suffer any prejudice whatsoever if PAN were permitted to  
7 amend its contentions. Finjan has known about SurfinGate, Check Point FireWall-1, and Digital  
8 Immune since long before it filed this action. These references were each identified as  
9 invalidating prior art in the Related Finjan Cases, SurfinGate is Finjan’s own product, and PAN  
10 disclosed Check Point FireWall-1 in its original contentions. Moreover, the Court has not yet set  
11 any dates for a *Markman* hearing, the close of fact or expert discovery, or trial. The complete  
12 lack of prejudice here is by itself dispositive and warrants granting PAN’s motion.

13 Accordingly, PAN's motion for leave to amend its invalidity contentions should be  
14 granted.

## 15 II. FACTUAL BACKGROUND

16 The stay of this case was lifted on January 25, 2021. (Dkt. No. 84.) In accordance with  
17 the procedural schedule, PAN’s initial invalidity contentions were due on May 17, 2021. (See  
18 Pat. L.R. 3-3, 3-4.) Long before that deadline, PAN served discovery seeking documents and  
19 information concerning prior art and invalidity contentions related to the Asserted Patents from  
20 the Related Finjan Cases, including prior art, invalidity contentions, claim charts, expert reports,  
21 and deposition and trial transcripts. (*See, e.g.*, Exs. 1, 2.)<sup>2</sup> But Finjan failed to produce this  
22 discovery, despite PAN’s repeated demands that it be produced. (Exs. 3, 4.) Finjan  
23 acknowledged the deficiencies in its production and promised to produce the withheld materials  
24 (Ex. 5) but failed to do so in advance of PAN’s May 17, 2021 deadline. Accordingly, PAN was  
25 forced to serve its initial invalidity contentions that day without the benefit of any of this critical

<sup>27</sup> References to “Ex. \_\_” are to exhibits to the Declaration of Michael DeStefano, dated December 30, 2021, filed herewith.

1 information from the Related Finjan Cases. (See Ex. 6.)

2       While Finjan continued to withhold prior art and invalidity-related information from the  
 3 Related Finjan Cases, the parties met and conferred regarding alleged issues related to PAN's  
 4 invalidity contentions. On June 8, the parties agreed that PAN would (1) provide a list of  
 5 obviousness combinations, including primary and secondary references for each combination,  
 6 (2) identify which references PAN believes are subject to *inter partes* review ("IPR") estoppel if  
 7 asserted alone or not in combination with a reference not subject to IPR estoppel, and (3) provide  
 8 additional descriptions for PAN's § 112 defenses. (Ex. 7 at 1.) The parties agreed that PAN  
 9 would supplement its contentions to provide this information on July 6, 2021, in parallel with its  
 10 preliminary election of prior art references. (*Id.*) PAN abided by the parties' agreement. On  
 11 July 6, 2021, PAN provided a list of all obviousness combinations that it intended to rely on.  
 12 (Ex. 8.) PAN's list included SurfinGate (a Finjan product), Check Point FireWall-1, and Digital  
 13 Immune. (*Id.* at 10-11, 22-24.) Finjan had been aware of these product references for years  
 14 because all of them had been asserted against the Asserted Patents in the Related Finjan Cases.

15       Finjan subsequently requested that PAN serve supplemental claim charts providing more  
 16 detail about the obviousness combinations that PAN disclosed in Appendix A to PAN's July 6  
 17 Contentions. (Ex. 9 at 1-2.) PAN worked to diligently serve these supplemental claim charts as  
 18 soon as possible but was thwarted by Finjan's continued obfuscation and delay. (Exs. 10, 11.)  
 19 For example, PAN specifically identified the materials it needed in order to complete the  
 20 supplemental claim charts. (Ex. 12 at Appx. A (citing specific documents related to SurfinGate  
 21 and Check Point FireWall-1).) PAN also identified additional materials relevant to invalidity that  
 22 Finjan had thus far failed to produce, including expert reports, deposition transcripts of fact and  
 23 expert witnesses, and trial transcripts of fact and expert witnesses. (*Id.* at 1-2.) But Finjan did not  
 24 provide the necessary information. (See Ex. 13.)

25       PAN was therefore stalled for weeks while it tried to finalize and serve supplemental  
 26 claim charts. For example, although Finjan produced Check Point FireWall-1-related claim  
 27 charts from the Related Finjan Cases, it continued improperly to withhold the cited documents  
 28 and source code. (Ex. 14; Ex. 15 at 1.) On September 2, PAN wrote to Finjan (1) stating that

1 Finjan's refusal to produce information about its own product (SurfinGate) was improper,  
 2 (2) requesting more information about Finjan's refusal to produce confidential information  
 3 (including documents related to Check Point FireWall-1), and (3) pointing out that Finjan still had  
 4 not provided many documents from the Related Finjan Cases. (Ex. 16.) Finjan responded that it  
 5 would not provide any of this information and the parties were unable to resolve this dispute.  
 6 (Ex. 17). PAN determined that it could wait no longer and that it would serve amended claim  
 7 charts based on the limited information that Finjan had produced. On October 6, 2021, PAN  
 8 served supplemental limitation-by-limitation claim charts corresponding to its July 6 Contentions.  
 9 (See Exs. 10, 11.) PAN still does not have all the materials necessary to prepare complete claim  
 10 charts for SurfinGate and Check Point FireWall-1. Finjan continues to refuse to produce any  
 11 additional documents related to SurfinGate.

### 12 **III. LEGAL STANDARD**

13 Patent Local Rule 3-6 permits a party to amend its contentions upon a "timely showing of  
 14 good cause." A showing of diligence is sufficient to establish good cause in the absence of undue  
 15 prejudice. *See Sunpower Corp. Sys. v. Sunlink Corp.*, No. C-08-2807 SBA (EMC), 2009 WL  
 16 1657987, at \*1-2 (N.D. Cal. June 12, 2009). Courts have also found good cause to amend where  
 17 there is a lack of prejudice regardless of diligence. *See Linex Techs., Inc. v. Hewlett-Packard Co.*,  
 18 No. C 13-159 CW, 2013 WL 5955548, at \*1 (N.D. Cal. Nov. 6, 2013); *see also Apple Inc. v.*  
 19 *Samsung Elecs. Co.*, No. CV 12-00630 LHK, 2012 WL 5632618, at \*6 (N.D. Cal. Nov. 15, 2012)  
 20 (granting leave to amend infringement contentions despite no showing of diligence because of  
 21 lack of prejudice to defendants). As demonstrated below, PAN easily satisfies this standard  
 22 because it acted diligently and its proposed amendments would not prejudice Finjan in any way  
 23 whatsoever.

### 24 **IV. ARGUMENT**

#### 25 **A. PAN Acted Diligently in Amending Its Invalidity Contentions**

##### 26 **1. PAN Diligently Identified and Disclosed SurfinGate, CheckPoint 27 FireWall-1, and Digital Immune**

28 Good cause exists for PAN to amend its invalidity contentions to include SurfinGate,

1 Check Point FireWall-1, and Digital Immune. PAN diligently requested materials from the  
 2 Related Finjan Cases on several occasions leading up to the deadline for its original invalidity  
 3 contentions. (*See, e.g.*, Exs. 3, 4.) Finjan acknowledged that it had a duty to provide these  
 4 materials (Ex. 5), but failed to provide any of them until June 2, 2021. PAN then promptly  
 5 supplemented its contentions by July 6, 2021, a deadline that the parties had agreed to for  
 6 supplemental contentions.

7 PAN was diligent in its disclosure of Check Point FireWall-1 against the '731 Patent.  
 8 PAN requested Check Point documents numerous times before serving its original contentions.  
 9 (*See, e.g.*, Ex. 4 at 1 ("We also expect this production to include prior art identified in all other  
 10 Finjan cases, ***including Check Point (3:18-cv-02621)*** – a Finjan case that was not identified in  
 11 your letter.") (emphasis in original).) On June 2, 2021, Finjan served for the first time a claim  
 12 chart from a Related Finjan Case that contained source code mappings from Check Point  
 13 FireWall-1. These source code mappings provided sufficient information for PAN to have a basis  
 14 to assert Check Point FireWall-1 against the '731 Patent. *See Radware, Ltd. v. F5 Networks, Inc.*,  
 15 No. C-13-2024-RMW, 2014 WL 3728482, at \*2-3 (N.D. Cal., July 28, 2014) (finding good cause  
 16 to amend where relevant source code was discovered, identified and received after infringement  
 17 contentions were already served). PAN's diligence in seeking these materials supports good  
 18 cause.

19 PAN likewise diligently served its amended contentions related to SurfinGate and Digital  
 20 Immune. As with Check Point FireWall-1, PAN had requested documents from the Related  
 21 Finjan Cases. (Ex. 4 at 1-2.) When Finjan provided a subset of materials from the Related Finjan  
 22 Cases on June 2, 2021, those materials included claim charts mapping SurfinGate and Digital  
 23 Immune to the Asserted Patents. These newly discovered claim charts, which had been  
 24 improperly withheld by Finjan, constitute new evidence and by themselves constitute good cause  
 25 for PAN to amend its invalidity contentions. *See THX Ltd. v. Apple, Inc.*, No. 13-cv-01161-HSG,  
 26 2016 WL 1718137, at \*1-3 (N.D. Cal., Apr. 29, 2016) (granting leave to amend five months after  
 27 receiving documents corroborating prior art previously identified as possible prior art by the  
 28 moving party). PAN asserted these references on July 6, 2021, the agreed-upon date by the

1 parties for service of PAN's supplemental invalidity contentions.

2 PAN's diligence continued after July 6, 2021. For example, to provide complete claim  
 3 charts for Check Point FireWall-1, PAN requested that Finjan produce the underlying source code  
 4 contained in the newly discovered Check Point FireWall-1 claim chart. (Ex. 12 at 1.) When  
 5 Finjan confirmed that it did not have the underlying source code in its possession, custody or  
 6 control on August 27, 2021 (Ex. 15 at 4), PAN prepared claim charts with the excerpts it had on  
 7 hand. PAN also diligently requested documents related to SurfinGate. (Ex. 16.) During the  
 8 course of those requests, Finjan refused to produce any additional documents related to  
 9 SurfinGate. (*See, e.g.*, Ex. 15 at 1; Ex. 17 at 1.) In light of that refusal, PAN served its claim  
 10 charts with the subset of materials Finjan has chosen to provide. PAN served all of its claim  
 11 charts simultaneously, and is moving to amend after serving all amended contentions, for  
 12 purposes of judicial economy. *THX*, 2016 WL 1718137, at \*2 (filing of serial motions to amend  
 13 early in the case would “elevat[e] form over substance and inefficiently use[] the resources of the  
 14 Court and the parties.”).

15 **2. PAN Diligently Amended Its Contentions Relating to Other Prior Art  
 16 References and Invalidity Grounds**

17 PAN acted with diligence regarding amendments to its invalidity contentions concerning  
 18 other prior art and invalidity arguments (collectively, “Other Sections”). Finjan requested that  
 19 PAN supplement its invalidity contentions on July 6, and PAN agreed to do so. (Ex. 7 at 1.)  
 20 Finjan therefore requested PAN’s amendments to include the Other Sections.

21 PAN has also exhibited good cause to amend its invalidity contentions to include the  
 22 claim charts it served on Finjan on October 6, 2021 related to the Other Sections. Finjan  
 23 requested that PAN provide claim charts including all of PAN’s asserted obviousness  
 24 combinations. (*Id.*) PAN indicated that it would serve amended claim charts once it received the  
 25 underlying documents necessary to create those claim charts. (Ex. 12 at 1 (“Finjan’s continuing  
 26 failure to timely supplement its production of these materials has prejudiced Palo Alto Networks’  
 27 []ability to complete its invalidity contentions.”).) The obviousness combinations themselves  
 28 were served on Finjan on July 6, 2021, as requested by Finjan. (*See* Ex. 6.) Good cause exists to

1 amend, because PAN diligently requested documents that were necessary to accommodate  
 2 Finjan's request for more detailed claim charts. Any delay was caused by Finjan. Soon after  
 3 Finjan confirmed it would give no more documents to PAN, PAN served its October 6  
 4 Contentions.

5 **B. Finjan Will Not Be Prejudiced by PAN's Proposed Amendments**

6 **1. Finjan Will Not Be Prejudiced by PAN's Assertion of SurfinGate,  
 7 Check Point FireWall-1, and Digital Immune**

8 Finjan will not be prejudiced by any of PAN's amendments. PAN repeatedly told Finjan  
 9 that PAN intended to rely on material from the Related Finjan Cases, which included Check Point  
 10 Firewall-1, SurfinGate, and Digital Immune. (*See, e.g.*, Ex. 3 at 1, Ex. 4.) PAN also reserved its  
 11 right to amend based on forthcoming materials from the Related Finjan Cases in its May 17, 2021  
 12 contentions. (*See, e.g.*, Ex. 6 at 5 (“To date, Finjan has not produced all relevant discovery  
 13 requested by PAN regarding, among other things, prior art systems and products; therefore, PAN  
 14 reserves the right to raise any such or further deficiencies with Finjan and/or the Court as needed  
 15 and further reserves the right to amend, modify, and/or supplement its Contentions.”).) As such,  
 16 Finjan cannot now claim to be prejudiced. *See THX*, 2016 WL 1718137, at \*1-3 (granting leave  
 17 to amend where notice of intent to amend based on new prior art was conveyed to non-moving  
 18 party); *Cellspin Soft, Inc. v. Garmin Int'l Inc.*, No. 17-cv-059354-YGR (KAW), 2021 WL  
 19 4923380, at \*2 (N.D. Cal., Aug. 10, 2021) (finding that even if diligence was lacking, prior notice  
 20 of new, relevant prior art did not prejudice plaintiff).

21 In addition, each of the relevant prior art references has been previously asserted against  
 22 Finjan in the Related Finjan Cases in connection with the very same Asserted Patents. This  
 23 additional prior notice further cuts against any possible prejudice to Finjan. *Cellspin*, 2021 WL  
 24 4923380, at \*2. Similarly, each of PAN's contentions against Check Point FireWall-1,  
 25 SurfinGate and Digital Immune are based on prior allegations of invalidity levied on Finjan in  
 26 claim charts produced by Finjan. Finjan knew about each of these allegations prior to May 17,  
 27 2021, and cannot be prejudiced by having them alleged by PAN in another case. For SurfinGate  
 28 in particular, there is no prejudice to Finjan. SurfinGate is a Finjan product that embodies

1 Finjan's patents. Finjan cannot claim surprise by having its own product again asserted against it  
 2 here.

3 Finally, despite being filed long ago, this case remains in the very early stages. The Court  
 4 has yet to set a deadline for the close of discovery, and there is plenty of time for Finjan to  
 5 conduct whatever fact and expert discovery it deems warranted in connection with Check Point  
 6 FireWall-1, SurfinGate, and Digital Immune. *THX*, 2016 WL 1718137, at \*3 (stating lack of  
 7 prejudice is "especially evident" where the Court has not yet set a discovery deadline, and where  
 8 the amendments did not alter any claim construction theories).

9 Accordingly, even had PAN not exercised the diligence that it did, good cause to amend  
 10 exists because the amendments do not prejudice Finjan. *Cellspin*, 2021 WL 4923380, at \*2  
 11 ("[T]he Court retains discretion to grant leave to amend even in the absence of diligence so long  
 12 as there is no prejudice to the opposing party" (internal quotations and citations omitted)).

13 **2. Finjan Will Not Be Prejudiced by PAN's Amendments Relating to  
 14 Other Prior Art References and Invalidity Grounds**

15 Finjan also was not prejudiced by the Other Sections of PAN's July 6 and October 6  
 16 Contentions. All invalidity grounds which PAN included in the Other Sections were timely  
 17 disclosed to Finjan on May 17, 2021, including all §§ 101, 102, 103, and 112 grounds. The only  
 18 information which PAN added was additional detail about its arguments on July 6, and further  
 19 additional detail in its claim charts on October 6. Finjan cannot claim it is prejudiced by these  
 20 additional details because every detail was included at Finjan's request. Moreover, the vast  
 21 majority of the prior art references included in PAN's Other Sections were asserted years ago  
 22 against Finjan in the Related Finjan Cases.

23 Finally, Finjan cannot claim it is prejudiced because there is sufficient time for Finjan to  
 24 seek discovery regarding PAN's Other Sections. A schedule for dates beyond claim construction  
 25 briefing have not yet been set, and no discovery deadlines have been ordered. Accordingly,  
 26 Finjan will have a plethora of opportunities to seek discovery from PAN, depose PAN's  
 27 witnesses, and examine PAN's Amended Contentions.  
 28

## V. CONCLUSION

For the foregoing reasons, PAN respectfully requests that the Court grant it leave to amend its invalidity contentions.

Dated: December 30, 2021

MORRISON & FOERSTER LLP

By: /s/ Diek O. Van Nort  
Diek O. Van Nort

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